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OFFICE OF PETITIONS

In re Application of:  
Sullenger, et al.  
Filed: 2 October, 1998  
Application No. 09/165,514  
Attorney Docket No. 00,888-J; 236/244

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. §1.137(b)<sup>1</sup> to revive the above-identified application filed herein on 19 November, 2001, but not received into the Office of Petitions until this writing.

The Office regrets the delay in addressing this matter.

The petition is **GRANTED**.

The record indicates that:

- Petitioner failed to respond timely and properly to a Notice of Missing Parts mailed on 21 October, 1998, to Petitioner's then Counsel with response due (absent extension of time) on or before 21 December, 1998;
- the instant application went abandoned after midnight 21 December, 1998;
- twenty (20) months after abandonment, Petitioner's then-Counsel filed on 22 August, 2000 (over a 16 August, 2000, certificate of mailing):

--a Notice of Change of Address; and

<sup>1</sup> Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

--a Status Inquiry (Petitioner's then-Counsel asserted therein that the filing constituted a second inquiry, however, no prior inquiry is evident in the record);

- following filing of a Revocation and Power of Attorney, and a Power to Inspect, the instant petition (with fee) was filed, accompanied by payment of the basic filing fee (small entity), surcharge for late payment, multiple dependent claim surcharge and a copy of the Notice of Missing Parts.<sup>2</sup>

The record (including the petition filed on 19 November, 2001) does not necessitate a finding that the delay between midnight 21 December, 1998, and 19 November, 2001, was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on Petitioner's (Donald Zuhn, Ph.D., Reg. No. 48,710) duty of candor and good faith when accepting Petitioner's representation that the delay in filing the response was unintentional.<sup>3</sup>

The instant application is being forwarded to OIPE for further processing.

Telephone inquiries regarding this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>2</sup> The fees were allocated as a petition fee for large entity (\$1,280.00), however, these fees are being reallocated as set forth above.

<sup>3</sup> See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).